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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/736,858      | 12/14/2000  | Jackson B. Hester JR. | 6295.N CNI          | 8319             |

7590                    04/24/2002

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 04/24/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                                      |                                      |
|---|--------------------------------------|--------------------------------------|
| <b>Office Action Summary</b>  | Application No.<br><b>09/736,858</b> | Applicant(s)<br><b>HESTER et al.</b> |
|   | Examiner<br><b>Brenda Coleman</b>    | Art Unit<br><b>1624</b>              |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>  |                                      |                                      |
| <b>Period for Reply</b>   |                                      |                                      |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  |                                      |                                      |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                                      |                                      |
| <b>Status</b>   |                                      |                                      |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Jan 29, 2002</u> .  |                                      |                                      |
| 2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.   |                                      |                                      |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.   |                                      |                                      |
| <b>Disposition of Claims</b>  |                                      |                                      |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-14, 16, 17, 22-25, 30-36, and 38-66</u> is/are pending in the application.   |                                      |                                      |
| 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.   |                                      |                                      |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed.  |                                      |                                      |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1-14, 16, 17, 22-25, 30-36, and 38-66</u> is/are rejected.   |                                      |                                      |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to.  |                                      |                                      |
| 8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.  |                                      |                                      |
| <b>Application Papers</b>   |                                      |                                      |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner.   |                                      |                                      |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.  |                                      |                                      |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.   |                                      |                                      |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.  |                                      |                                      |
| <b>Priority under 35 U.S.C. § 119</b>   |                                      |                                      |
| 13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  |                                      |                                      |
| a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:<br>1. <input type="checkbox"/> Certified copies of the priority documents have been received.<br>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.<br>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).   |                                      |                                      |
| *See the attached detailed Office action for a list of the certified copies not received.   |                                      |                                      |
| 14) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  |                                      |                                      |
| <b>Attachment(s)</b>  |                                      |                                      |
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)   |                                      |                                      |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   |                                      |                                      |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____  |                                      |                                      |
| 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____   |                                      |                                      |
| 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |                                      |                                      |
| 20) <input type="checkbox"/> Other: _____   |                                      |                                      |

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## **DETAILED ACTION**

Claims 1-14, 16, 17, 22-25, 30-36 and 38-66 are pending in the application.

This action is in response to applicants' amendment dated January 29, 2002. Claims 1, 8, 9, 17, 22, 24 and 25 have been amended; claims 15, 18-21, 26-29 and 37 have been canceled and claims 38-66 are newly added.

### ***Response to Arguments***

Applicants' arguments filed January 29, 2002 have been fully considered with the following effect:

1. The applicants' arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection in the last office action, which is hereby **withdrawn**.
  
2. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of the last office action, which are hereby **withdrawn**.
  
3. The applicants' arguments are sufficient to overcome the 35 U.S.C. § 103 obviousness rejections in the last office action, which are hereby **withdrawn**.

In view of the amendment dated January 29, 2002, the following new grounds of rejection apply:

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14, 16, 17, 22-25, 30-36 and 38-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1 and 30-36 are vague and indefinite in that it is not known what is meant by the proviso within the definition of W. There is no structure iv in formula I.
- b) Claim 1 is vague and indefinite in that it is not known what is meant by the period following the definition of X.
- c) Claims 1-14, 16, 17, 22, 30-36, 38 and 42 are vague and indefinite in that it is not known what is meant by the variable R<sup>7</sup> within the definition of the alkyl and phenyl substituents for which there is no definition.
- d) Claims 1-14, 16, 17 and 30-36 are vague and indefinite in that it is not known what is meant by the definition of substituents for each occurrence of phenyl. It is not known which phenyls this refers to.
- e) Claims 1-13, 16, 22-25, 30-36 and 38-45 are vague and indefinite in that it is not known what is meant by the proviso where k and j taken together are 2, 3, 4 or 5, since there is no k in formula I.
- f) Claims 2-14, 16, 17, 22-25 and 38-45 are vague and indefinite in that it is not known what is meant by “a compound of formula I”. It is not clear what applicants mean by “a compound of formula I”, this does not permit the claim as

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written to stand alone. There is no dependency to a previous claim and therefore the claim as an independent claim must include the meanings of any and all substituents and the structure of formula I.

- g) Claim 46 is vague and indefinite in that it is not known what is meant by “carbnonyl” in the second from the last species in the claim.
- h) Claim 46 contain a capital letter, i.e. Fluoro in the last species of the claim.
- i) Claims 47, 57-64 and 66 are vague and indefinite in that it is not known what is meant by the proviso within the definition of W. There is no structure iv in formula I.
- j) Claims 47-64 and 66 are vague and indefinite in that it is not known what is meant by the proviso within the definition of X. There is no subsection (b) within formula I.
- k) Claim 47 is vague and indefinite in that it is not known what is meant by the period following the definition of X.
- l) Claims 47-56, 58, 60 and 66 are vague and indefinite in that it is not known what is meant by the variable R<sup>7</sup> within the definition of the alkyl and phenyl substituents for which there is no definition.
- m) Claims 47-56, 58, 60 and 66 are vague and indefinite in that it is not known what is meant by the definition of substituents for each occurrence of phenyl. It is not known which phenyls this refers to.

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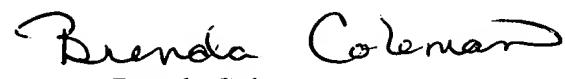
- n) Claims 47-64 and 66 are vague and indefinite in that it is not known what is meant by the proviso where k and j taken together are 2, 3, 4 or 5, since there is no k in formula I.
- m) Claims 47-64 and 66 are vague and indefinite in that it is not known what is meant by the definition of n, since there is no variable n in formula I.
- n) Claim 52 does not end with a period.
- o) Claim 58 recites the limitation "methyl and CF<sub>3</sub>" in the definition of the substituents for the phenyl of R<sub>5</sub>. There is insufficient antecedent basis for this limitation in the claim.
- p) Claim 65 is vague and indefinite in that it is not known what is meant by "carbnonyl" in the second from the last species in the claim.
- q) Claim 65 contain a capital letter, i.e. Fluoro in the last species of the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Brenda Coleman  
Primary Examiner AU 1624  
April 21, 2002